UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Application of	:	
Philip E. Thorpe et al	:	
Serial No.: 09/351,862	:	PETITION DECISION
Filed: July 12, 1999	:	
Attorney Docket No.: 4001.002282	:	

This letter is in response to the petition under 37 CFR 1.181, filed June 6, 2003, requesting withdrawal of the finality of the last Office action.

BACKGROUND.

A review of the file history shows that a first examiner mailed a first Office action to applicants on September 21, 2000, setting a one month shortened statutory period for reply. The examiner required restriction between the claims, dividing the claims into four groups. Applicants replied on November 14, 2000, traversing the requirement, but making no specific election of any of the groups identified.

A new examiner mailed a new restriction requirement to applicants on January 29, 2001, responding in part to the traverse and reducing the number of groups to three and providing proper reasons for distinctness therebetween. Applicants replied on February 20, 2001, with an election of Group I for prosecution purposes and traversal of the requirement.

In the next Office action, mailed May 8, 2001, the examiner replied to the traversal of the restriction requirement , but did not make it Final. The examiner then rejected claims 1, 3-12, 14-15 and 19-29 under 35 U.S.C. 112, second paragraph, as indefinite. Claims 1, 12, 14-15 and 19-29 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement and other reasons. Claims 1, 3-12, 14-15 and 19-29 were rejected under 35 U.S.C. 103(a) as unpatentable over Fishman et al and Umeda in view of Huang et al and Blankenberg et al and WO98/29453. Claims 1, 3-12, 14-15 and 19-29 were also rejected under 35 U.S.C. 103(a) as unpatentable over Fishman et al and Umeda in view of Huang et al and Blankenberg et al and further in view of Ginbrone, Dvorak et al and WO 98/29453. Applicants replied on April 1, 2002, by adding claims 39-42, and addressing all of the rejections.

The examiner mailed a second non-Final Office action to applicants on December 12, 2001, rejecting claims 1, 3-12, 14-15, 19-29 and 34-35 under 35 U.S.C. 112, second paragraph, as indefinite. Claims 1, 3-6, 8, 12, 14 and 19 were rejected under 35 U.S.C. 102(b) as anticipated by Fishman et al. Claims 1, 3-12, 14, 19-22 and 39-42 were rejected under 35 U.S.C. 102(e) as anticipated by Schroit. Claims 23-29 and 34-35 were rejected under 35 U.S.C. 103(a) as unpatentable over Schroit in view of Ginbrone and Umeda. Claims 7, 9-11, 20-29, 34-35 and 39-42 were rejected under 35 U.S.C. 103(a) as unpatentable over Fishman et al in view of Newman et al and Ginbrone Applicants replied on August 29, 2002, by amending claims 1, 30, 34 and 38 and adding claim 43 and by addressing all of the rejections of record.

The examiner mailed a Final Office action to applicants on October 22, 2002, rejecting claims 1, 3-12, 14, 19-22 and 39-43 under 35 U.S.C. 102(e), as anticipated by Schroit. Claims 1, 3-12, 14, 19-29, 34-35 and 39-43 were rejected under 35 U.S.C. 103(a) as unpatentable over Schroit in view of Ginbrone and Umeda.

An amendment after Final Office action and a Notice of Appeal were submitted on April 28, 2003, in which applicants proposed adding claims 44-48 and amending claim 12. Applicants argued the finality of the previous Office action as being premature as well as replying to the grounds of rejection. The examiner mailed an Advisory action to applicants on May 29, 2003, refusing entry of the amendment and refusing to withdraw finality for various reasons.

This petition was then filed on June 6, 2003.

DISCUSSION

Applicants contend that the finality of the last Office action was premature in that a new ground of rejection was entered which was not necessitated by any amendment of applicants. They also state that the amendment after Final rejection requested withdrawal of finality of the Office action, but was refused.

Applicants specifically point out that claims 39-42 were not rejected in the Office action of May 8, 2002, under 35 U.S.C. 103(a) over Schroit in view of Ginbrone and Umeda, but were so rejected in the Office action of October 22, 2002. Applicants are correct in their statement. However it is noted that claims 39-42 were previously rejected over Schroit alone under 35 U.S.C. 102(e) in the earlier Office action which rejection was maintained in the last and Final Office action. A rejection under 35 U.S.C. 102 for anticipation is the epitome of obviousness under 35 U.S.C. 103. Thus an examiner making a rejection under 35 U.S.C. 102 of a set of claims inherently makes a rejection under 35 U.S.C. 103 of those same claims for the same reasons whether it is overtly expressed in the Office action or not. In this instance the examiner did fail in the earlier Office action to overtly express a rejection of all active claims under 35 U.S.C. 103, limiting the claims rejected thereunder to those not specifically rejected under 35 U.S.C. 102. The omission was corrected in the Final Office action by rejecting the same claims under 35 U.S.C. 102(e), as before, and also rejecting all claims under 35 U.S.C. 103. It is noted that some of the claims were amended (claims 1, 3-12, 14, 19-22) directly or indirectly, but were still rejected under 35 U.S.C. 102(e) and newly rejected under 35 U.S.C. 103 and that other claims which were not amended

(claims 39-42), but which had been rejected under 35 U.S.C. 102(e) were also newly rejected under 35 U.S.C. 103. It is noted that the primary reference (Schroit) used under 35 U.S.C. 103 to reject the claims is the same reference used under 35 U.S.C. 102(e) to show anticipation. Thus applicant was well aware of the reference and the application of its teachings under both 35 U.S.C. 102(e) and, inherently, 35 U.S.C. 103(a).

DECISION

The petition is **DENIED** for the reasons set forth above. Finality of the last Office action is deemed to be proper.

Applicants remain under obligation to file an Appeal Brief within the time period set in 37 CFR 1.192(a) or as may be extended under 37 CFR 1.136(a), or take other appropriate action.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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